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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,018	11/16/2000	Harry Thomas Kloor	18822-00011/US	5553
<div>7590 07/19/2007 Christopher R. Hilberg Oppenheimer Wolff &amp; Donnelly LLP Suite 3300 45 South Seventh Street Minneapolis, MN 55402</div>			<div>EXAMINER THEIN, MARIA TERESA T</div> <div>ART UNIT 3627</div> <div>MAIL DATE 07/19/2007</div> <div>PAPER NUMBER</div>	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/714,018	<b>Applicant(s)</b> KLOOR, HARRY THOMAS	
	<b>Examiner</b> Marissa Thein	<b>Art Unit</b> 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-57 and 59-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-57 and 59-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 15, 2007 has been entered.

### ***Response to Amendment***

Applicants' "Request for Continued Examination" filed on May 15, 2007 has been considered.

Claims 1-57 and 59-62 remain pending in this application.

### ***37 U.S.C. 1.131 Declaration***

The Declaration filed on May 15, 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the following references:

U.S. Patent No. 6,473,740 to Cockrill et al.;  
U.S. Patent No. 6,055,505 to Elston;  
U.S. Patent No. 6,330,550 to Brisebois et al.;  
U.S. Patent No. 6,330,672 to Shur;  
U.S. Patent No. 6,442,526 to Vance et al.; and  
U.S. Patent No. 6,390,362 to Martin.

The Declaration does not clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere

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pleading, unsupported by proof or a showing of facts" and, thus does not satisfy the requirements of 37 CFE 1.131(b). Applicants must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the U.S. Patent No. 6,473,740 to Cockrill et al.; U.S. Patent No. 6,055,505 to Elston; U.S. Patent No. 6,330,550 to Brisebois et al.; U.S. Patent No. 6,330,672 to Shur; U.S. Patent No. 6,442,526 to Vance et al.; and U.S. Patent No. 6,390,362 to Martin references. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). In establishing conception, Applicant must show possession of every feature recited in the claim, and that every limitation of the claim must have been known to the inventor at the time of the alleged conception. There should be an adequate nexus between the evidence and every feature recited in the claim. The applicant has to establish a probative relation between the submitted evidence and every feature or limitation of the claim. Conception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill. See MPEP 2138.04.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the U.S. Patent No. 6,473,740 to Cockrill et al.; U.S.

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Patent No. 6,055,505 to Elston; U.S. Patent No. 6,330,550 to Brisebois et al.; U.S. Patent No. 6,330,672 to Shur; U.S. Patent No. 6,442,526 to Vance et al.; and U.S. Patent No. 6,390,362 to Martin references to either a constructive reduction to practice or an actual reduction to practice. Applicant does not show evidence of facts establishing diligence; it is not enough merely to allege that applicant or patent owner had been diligent. Diligence requires that applicant must be specific as to dates and facts. Applicant should give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. The critical period in which diligence must be shown begins just prior to the effective date of each of the references or activity and ends with the date of a reduction to practice, either actual or constructive. The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. See MPEP 715.07(a) and 2138.06.

The evidence (reproduction of notebook entries) submitted is somewhat illegible. Examiner suggest for Applicant to submit a certified legible copy of the submitted evidence, in order to understand the writings in the evidence.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-10, 12-14, 16, 18, 20-27, 29-31, 33, 56, and 59-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,529,725 to Joao et al. in view of U.S. Patent No. 6,473,740 to Cockrill et al.**

Regarding **claim 1**, Joao discloses a method for authorizing a transaction comprising: sending, receiving, and storing contact information (database(s) 3H; see col. 16, lines 4-13; col. 6, lines 15-21; col. 31, lines 49-62); initiating into a credit card transaction (col. 5, lines 24-29); sending the authorization request to the user from an authorization agent (col. 6, lines 15-47), wherein the authorization agent is a bank that issued the credit card to the user, a credit card company, or an agent of the bank or the credit card company (col. 13, lines 52-65); receiving the authorization request, wherein the authorization request is received by the user and sending a response to the authorization request from the user (col. 6, lines 37-65); receiving the response, wherein the response is received by the authorization agent and completing the transaction (col. 7, lines 18-40); **[claims 2-5, 12-14]** over the Internet (col. 10, lines 3-10); using email (col. 10, lines 46-49); a telephone line (col. 4, line 66 – col. 5, line 1; col. 5, lines 16-17), or wireless system (col. 5, lines 16-18), or a personal communication device (col. 67 – col. 5, line 6), or a cellular telephone (col. 29, lines 10-25; col. 32, lines 20-29) or pda (col. 38, lines 5); **[claims 6-7]** initiating the transaction includes transmitting a credit card number to a payee of the transaction (col. 5, lines 31-43) at an online store (col. 13, lines 7-20); **[claims 8-10]** a soft-card software for authorization (col. 7, lines 45-67; col. 16, lines 4-31); and **[claim 16]** information is entered into a website (col. 10, lines 3-6).

Joao does not explicitly disclose the personal data of the user that verifies the user's identity. Joao disclose the apparatus is designed or programmed to telephone the cardholder, account owner and cellular telephone owner at a primary phone number, at an alternate or forwarding phone number, and/or business phone number, send fax message, an electronic mail message, etc to, or for the card holder, account owner, and cellular telephone owner, to ensure that best efforts are to be made to communicate with the desired individual as soon as possible (col. 10, lines 53-67). Furthermore, Joao also discloses a database 3(H) which contains account information and data about the card holder accounts or owner and other information and data necessary to manage and process and account transaction (col. 16, lines 4-12). Moreover, Joao discloses the account owner may program the apparatus for proof of identity of which the types of proof may be specified (col. 42, lines 41-42).

Cockrill, on the other hand, teaches the personal data of the user that verifies the user's identity (col. 11, lines 36-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Joao, to include the personal data of the user that verifies the user's identify, in order to validate whether the personal information collected matches the credit card number (Cockrill, col. 11, lines 45-47).

Regarding **claim 18**, Joao discloses a method for allowing an owner to approve a transaction comprising: acquiring contact information (database(s) 3H; see col. 16, lines 4-13; col. 6, lines 15-21; col. 31, lines 49-62); receiving a request to authorize (col. 6, lines 37-65), wherein the authorization agent is a bank, a credit card company, or an

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agent of the bank or the credit card company (col. 13, lines 52-65); using the contact information to the send the request (col. 6, lines 37-65, col. 7, lines 18-40; col. 31, lines 49-62); and sending approval (col. 6, lines 37-65, col. 7, lines 18-40); **[claims 20-27, 30-31, 33]** as set forth above for claims dependent from claim; and **[claim 29]** monitoring the owner and using the latest information to send the request to the owner (col. 10, lines 31-41).

Joao does not explicitly disclose receiving a request to authorize a transaction, subsequent to acquiring the contact information. Joao disclose the apparatus is designed or programmed to telephone the cardholder, account owner and cellular telephone owner at a primary phone number, at an alternate or forwarding phone number, and/or business phone number, send fax message, an electronic mail message, etc to, or for the card holder, account owner, and cellular telephone owner, to ensure that best efforts are to be made to communicate with the desired individual as soon as possible (col. 10, lines 53-67).

Furthermore, Joao also discloses a database 3(H) which contains account information and data about the card holder accounts or owner and other information and data necessary to manage and process and account transaction (col. 16, lines 4-12).

Cockrill, on the other hand, teaches the receiving a request to authorize a transaction, subsequent to acquiring the contact information (col. 10, line 66 – col. 11, line 12; col. 11, lines 13-60; Figure 8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Joao, to include the receiving a



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request to authorize a transaction, subsequent to acquiring the contact information, in order to validate the credit card number by matching the information collected from the customer to the credit card number (Cockrill, col. 11, lines 45-47).

Regarding **claim 56**, Joao discloses a method for parties to communication a transaction as set forth above in detail for claim 1.

Regarding **claim 59**, Joao discloses a system for authorization a transaction, comprising a server (col. 13, lines 66 – col. 14, line 3); a card registered with the server (col. 13, lines 51-65); and **[claims 60-62]** a credit card transaction over the Internet (col. 5, lines 24-29; col. 10, lines 3-10).

Joao does not explicitly disclose a communication channel, subsequent to the card being registered with the server. Joao disclose the apparatus is designed or programmed to telephone the cardholder, account owner and cellular telephone owner at a primary phone number, at an alternate or forwarding phone number, and/or business phone number, send fax message, an electronic mail message, etc to, or for the card holder, account owner, and cellular telephone owner, to ensure that best efforts are to be made to communicate with the desired individual as soon as possible (col. 10, lines 53-67).

Furthermore, Joao also discloses a database 3(H) which contains account information and data about the card holder accounts or owner and other information and data necessary to manage and process and account transaction (col. 16, lines 4-12).

Cockrill, on the other hand, teaches a communication channel, subsequent to the card being registered with the server (col. 10, line 66 – col. 11, line 12; col. 11, lines 13-60; Figure 8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Joao, to include a communication channel, subsequent to the card being registered with the server, in order to validate the credit card number by matching the information collected from the customer to the credit card number (Cockrill, col. 11, lines 45-47).

**Claims 11, 17, 28, 36, 37, 39, and 40 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,529,725 to Joao et al. in view of U.S. Patent No. 6,055,505 to Elston.**

Joao substantially discloses the claimed invention, however, it does not disclose requiring a password/PIN.

Elston discloses a password/PIN (col. 3, line 49 – col. 4, line 8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Joao, to include a password/PIN, as taught by Elston, because passwords/PINS provided added security to protect confidential information.

**Claims 15 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao in view of U.S. Patent No. 5,760,771 to Blonder et al.**

Joao substantially discloses the claimed invention, however, it does not disclose the use of an e-signature for an agreement.

Blonder teaches the use of e-signatures (see column 9, lines 24-32).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Joao with e-signatures as taught by Blonder, because e-signatures add an additional level of security from fraud.

**Claims 19 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao in view of U.S. Patent No. 6,330,550 to Brisebois et al.**

Joao substantially discloses the claimed invention, however, Joao does not disclose IP address.

Brisebois teaches the IP address (col. 4, lines 55-63).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Joao with the IP address, as taught by Brisebois, because the IP address provided security to protect confidential information.

**Claim 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao in view U.S. Patent No. 6,330,672 to Shur.**

Joao substantially discloses the claimed invention, however, it does not disclose the use of a digital watermark.

Shur teaches the use of digital watermarks (see column 2, lines 20-30 and column 4, lines 56-64).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Joao with digital watermarks as taught by Shur, because digital watermarks add an additional level of security from fraud.

**Claims 35, 42-46, and 51-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao in view of U.S. Patent No. 6,442,526 to Vance et al.**

Joao substantially discloses the claimed invention, however, it does not disclose the owner includes other users that are authorized by the owner.

Vance teaches the use of preapproving employee corporate credit card usage for selected purchases (see column 2, lines 49-60 and paragraph bridging columns 5-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Joao with the secondary card users as taught by Vance, because preapproving purchases by employees allows the organization to keep tighter control over spending.

**Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao in view of Elston as applied to claim 36 above, and further in view of Official Notice.**

Joao and Elston substantially disclose the claimed invention, however, the combination does not disclose that contact information is only established for a predetermined amount of time.

The Examiner takes Official Notice that is old and well known in the art to change PINs or passwords after a predetermined period of time.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination with changing PINs/passwords, because modifying PINs provides an additional level of security from fraud.

**Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao in view of Elston and Vance.**

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Joao and Elston substantially disclose the claimed invention, however, the combination does not disclose the owner includes other users that are authorized by the owner.

Vance teaches the use of preapproving employee corporate credit card usage for selected purchases (see column 2, lines 49-60 and paragraph bridging columns 5-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination with the secondary card users as taught by Vance, because preapproving purchases by employees allows the organization to keep tighter control over spending.

**Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao in view of Vance as applied to claim 42 above, and further in view of Official Notice.**

Joao and Vance substantially disclose the claimed invention, however, the combination does not disclose an electronic wallet.

The Examiner takes Official Notice that using an electronic wallet for online purchases is old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination with an electronic wallet as is well known in the art, because electronic wallets store important personal and account information in a secure and easy to use format.

**Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao in view of Vance as applied to claim 42 above, and further in view of U.S. Patent No. 6,390,362 to Martin.**

Joao and Vance substantially disclose the claimed invention, however, the combination does not disclose a check with a bar code.

Martin teaches the use of a check with a barcode (see column 4, lines 5-19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination with check payment with a barcode as taught by Martin, because utilizing a check with a barcode adds an additional level of security to reduce fraud.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mtrot  
July 17, 2007

 7/17/07

**MICHAEL CUFF**  
**PRIMARY EXAMINER**